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09/888,464	06/25/2001	Douglas E. Bise	K-1816	8703

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/888,464

Applicant(s)

BISE ET AL.

Examiner

Jennifer H Gay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19-21, 23, 25-35 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-21, 23, 25-35 and 37-39 is/are rejected.
- 7) ☒ Claim(s) 4, 5 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 6, 7, 14, 15, 19-21, 25-28, 30-35, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver et al. (US 2,894,726) in view of Adams et al. (US 4,189,013, cited by applicant).

*Regarding claims 1, 19, 23, 26, 32, and 37-39:* Weaver et al. discloses a rotary drag bit.

The bit includes the following features:

- An elongate body (12) with a peripheral surface.
- An insert (18) affixed to the axial forward end of the body and having a central longitudinal axis.
- Three discrete leading cutting edges (26) that are stepped.

It should be noted that the functional recitation that the steps improve the disintegration of the earth strata has not been given patentable weight because it is narrative in form. In order to be given weight, a functional recitation must be expressed as a "means" for performing the specified function, as set forth in 35 USC 112, 6<sup>th</sup> paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279. It has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973).

Weaver et al. discloses all of the limitations of the above claims except for the insert being a monolithic hard insert. As seen in Figures 8 and 9, Adams et al. teaches a rotary drag bit that includes a monolithic hard insert member. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the insert of Weaver et al. so that it was a monolithic hard insert as taught by Adams et al. in order to have formed a

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bit that did not include separate pieces that may be sheared off during drilling thus increasing the life of the bit.

*Regarding claims 2, 8, and 33:* The stepped cutting edge includes an upper and lower step (28).

*Regarding claim 3:* The leading cutting edge of the upper and lower step are parallel (see Figures 1 and 2).

*Regarding claims 6 and 28:* The bit further includes a central longitudinal axis that passes through the insert and each of the leading cutting edges begins at a point radially outward from the central axis and extends away from that axis (see Figure 1 and 2).

*Regarding claim 7:* The leading cutting edges are formed by a corresponding leading edge of the insert that intersects the top surface of the insert (see Figure 1 and 2).

*Regarding claims 14, 20, 30, and 34:* The upper and lower steps have generally planar rake surfaces (see Figures 1 and 2).

*Regarding claims 15, 21, 31, and 35:* The angle of the lower rake surface is different from the angle of the upper rake surface (see Figure 28).

*Regarding claim 25:* The insert further includes a side clearance cutting edge (see Figures 1 and 3).

3. Claims 10-12, 16, 17, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver et al. (US 2,894,726) in view of Adams et al. (US 4,189,013, cited by applicant) as applied to claims 1, 2, 15, 23, and 26 above, and further in view of Brady (US 5,180,022).

Weaver et al. and Adams et al. disclose all of the limitations of the above claims except for the cutting edges of the different steps having a rake angle between 0 and negative 15 degrees. In column 5, lines 20-60, Brady teaches a rotary mining tool that includes an insert with a rake angle between negative 5 and 35 degrees. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the drill bit of Weaver et al. in view of Adams et al. so that the cutting edges of the different steps having a rake angle between 0 and negative 15 degrees as taught by Brady in order to have reduced the tensile load on the insert thus lengthening the life of the bit.

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4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver et al. (US 2,894,726) in view of Adams et al. (US 4,189,013, cited by applicant) as applied to claims 1 and 2 above, and further in view of Nance (US 5,269,387).

Weaver et al. and Adams et al. disclose all of the limitations of the above claims except for the upper step cutting edge having a relief angle of about 30 degrees and the lower step having a relief angle of about 21 degrees. In column 2, lines 20-40, Nance teaches a first relief angle between 30 and 60 degrees and a second relief angle between 18 and 35 degrees; the two different locations could broadly be considered an upper and lower step. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have formed the cutting edges of the steps of Weaver et al. in view of Adams et al. so that the upper step cutting edge having a relief angle of about 30 degrees and the lower step having a relief angle of about 21 degrees as taught by Nance in order to have provided a drill bit that had significantly improved effectiveness when drilling elongated roof bolt holes (see col. 2, lines 60-65).

### ***Allowable Subject Matter***

5. Claims 4, 5, and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

6. It is noted that claims 18, 22, 24, and 36 have been canceled.

7. In view of applicant's amendment, the objection to claims 5, 8, and 23 has been withdrawn.

8. In response to applicant's argument that element 14 of Weaver et al. is not the leading cutting edge, the examiner agrees; element 26 is in fact the leading cutting edge.

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9. In response to applicant's argument that Weaver et al. does not teach a monolithic hard insert member with at least three cutting edges, the examiner agrees that Weaver et al. does not teach a monolithic insert. However, Figure 2 shows that the bit has at least three cutting edges.

10. In response to applicant's argument that there is no motivation to modify the lower cutting edge of Weaver et al. to have a negative 20 slope, the examiner agrees and the rejection of claim 4 has been withdrawn.

11. In response to applicant's argument that the examiner used hindsight with respect to the optimum step height of the bit, the examiner agrees and the rejection of claims 5 and 9 have been withdrawn.

12. Applicant's arguments with respect to claims 1-9, 14, 15, 19-21, 23, 25-28, and 30-35 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's arguments with respect to claims 10-13, 16, 17, and 29, filed 13 January 2003, have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., tensile fracture problems) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the relief angles of Nance are disclosed as being equal, the examiner agrees. However, it is also disclosed that they may be different.

### **Conclusion**


14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Friday, 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JHG/DAW  
February 28, 2003

  
DAVID BAGNELL  
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